al. (hereafter "Afify), U.S. Patent 5,291,485, and claims 4, 5 and 10 are rejected under 35 U.S.C. §103(a) as being unpatentable over Afify as applied to claim 1, and further in view of Dobbins et al. (hereafter "Dobbins"), U.S. Patent 5,825,772. Consideration of the application in view of the following remarks is respectfully requested.

Claims 1-19 are pending the application. No claims have been cancelled or amended. No new claims have been added.

It is noted that several inadvertent typographical errors in the specification have been corrected by the foregoing amendments. It is respectfully requested that the Examiner approve and enter these minor corrections.

The Examiner has rejected claims 1-3, 6-9 and 11-19 under 35 U.S.C. § 103(a) as being unpatentable over Afify. This rejection by the Examiner is respectfully traversed.

Applicant begins with claim 1, which specifically recites:

A method of interleaving a data stream comprising:
writing a sequence of groupings of bits from the data stream, the groupings having a predetermined size, from a data bus into a memory;
applying selected groupings read from the memory to a first multiplexer (MUX);
applying the groupings applied to the first MUX to a second MUX; and
applying at least one grouping to the second MUX between applying groupings from the first MUX to the second MUX.

The Examiner has referenced Applicant's assertion that "[t]here are many reasons" why "the Afify patent does not render obvious the invention as recited in claim 1." In this regard, the Examiner states that "Applicant may want to specify what the many reasons are." It is respectfully noted that Applicant has provided examples of these reasons in the Amendment dated August 6, 1999 on page 3, last paragraph, which continues onto page 4. Applicant respectfully asserts that these examples are sufficient to overcome the Examiner's rejection. However, in the interest of furthering prosecution, the Examiner's rejection is further traversed.

First, Applicant respectfully asserts that the reference cited by the Examiner is not analogous to the embodiment recited in claim 1. The standard the courts use for determining if a reference is analogous, and therefore proper for an obviousness analysis, is twofold. First, it is determined whether the reference is within the field of the inventor's endeavor. Second, if it is not, it must be determined if the reference is reasonably pertinent to the particular problem facing the inventor. This test has been applied by the Federal Circuit in a number of cases, such as In re Deminski, 230 USPQ 313, 315 (Fed. Cir. 1986). Under this test, Applicant respectfully asserts that the reference cited by the Examiner does not meet the standard for use in an obviousness analysis.

With respect to the first part of the test, the referenced cited by the Examiner is not within the field of Applicant's endeavor, interleaving data streams. One of ordinary skill in the art, in the course of solving the problem of interleaving data streams would not look to the art of synchronous optical network virtual tributary translation. **Claim 1 in no way relates to virtual tributaries or synchronous optical networks and, therefore, Afify cannot be considered to be within the field of Applicant's endeavor.**

As the cited patent is not within the field of Applicant's endeavor, the second prong of the test must be examined. Applicant respectfully asserts that the cited patent is also not pertinent to the particular problem addressed by claim 1. Again, claim 1 is directed to a method of interleaving data streams. **One of ordinary skill in the art would not look to a reference dealing with synchronous optical networks to solve the problem of interleaving data streams.** Therefore, the cited reference is not analogous to claim 1 and cannot render that claim obvious.

Second, notwithstanding the above, Applicant also respectfully asserts that the Examiner's obviousness rejection is based on hindsight analysis, which has been proscribed consistently by the Federal Circuit. For example, in In re Gorman, 18 USPQ2d 1885

(Fed. Cir. 1991) the court specifically stated:

> As in all determinations under 35 U.S.C. § 103, the decisionmaker must bring judgment to bear. It is impermissible, however, simply to engage in a hindsight reconstruction of the claimed invention, using the applicant's structure as a template and selecting elements from references to fill the gaps. (citation omitted) The references themselves must provide some teaching whereby the applicant's combination would have been obvious.

In the Detailed Action, the Examiner, in rejecting claim 1, takes each element of the claim and selects corollary elements from the cited patent without any indication of how the reference teaches claim 1. Applicant respectfully asserts that the Examiner's rejection is the type of hindsight analysis that the Federal Circuit has explicitly proscribed.

Third and finally, it is well settled that in order establish a *prima facie* case of obviousness the teachings of the prior art must suggest the claimed invention to one of ordinary skill in the art. The Federal Circuit has addressed this principle in a number of cases, for example In re Bell, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993), where the court specifically stated:

> "A *prima facie* case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art." (citation omitted)

Applicant respectfully asserts that the patent cited by the Examiner fails to establish a *prima facie* case of obviousness.

In this regard, the teachings of the cited patent would not suggest the subject matter of claim 1 to one of ordinary skill in the art. **The portions of the Afify patent cited by the Examiner, and the patent as a whole, do not relate to interleaving a data stream as recited in claim 1.** The teachings of Afify are directed at converting from one virtual tributary (VT) format into another VT format in a synchronous optical network (SONET), as discussed, for example, at page 2, lines 61-66 of that patent. Therefore, Applicant

respectfully asserts that the cited patent would not suggest claim 1 to one of ordinary skill in the art.

Based on the foregoing, Applicant respectfully asserts that claim 1 distinguishes the cited patent. It is respectfully requested that the Examiner withdraw his rejection as to claim 1.

Claims 2-3, 6-9 and 11 depend from and include all the limitations of claim 1. Therefore, these claims distinguish the cited patent on the same basis as claim 1. It is respectfully requested that the Examiner withdraw his rejection of these claims.

The Examiner has also rejected claims 12 and 18. It is respectfully asserted these claims patentably distinguish from the cited patent for similar reasons as discussed with respect to claim 1. Therefore, it is respectfully requested that the Examiner withdraw his rejection of these claims.

Claims 13-17 depend from and include all of the limitations of claim 12. Therefore, these claims patentably distinguish on the same basis as claim 12. It is respectfully requested that the Examiner withdraw his rejection of these claims.

Claim 19 depends from and includes all of the limitations of claim 18. Therefore, this claim patentably distinguishes on the same basis as claim 18. It is respectfully requested that the Examiner withdraw his rejection of this claim.

The Examiner has rejected claims 4-5 and 10 under 35 U.S.C. § 103(a) as being unpatentable over Afify as applied to claim 1, and further in view of Dobbins, as set forth in the previous rejection. Claims 4-5 and 10 depend from and include all the limitations of claim 1. The remarks above regarding claim 1 apply here as well and are incorporated by reference. Even assuming, merely for the purpose of making this legal argument, that the proposed combination is proper, which Applicant specifically does not concede, still the combination of Afify and Dobbins would not render the invention, as claimed, obvious, for

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the reasons discussed above regarding claim 1. Therefore, it is respectfully requested that the Examiner withdraw his rejection as to claims 4-5 and 10.

CONCLUSION

In view of the foregoing, it is respectfully asserted that all of the claims pending in this patent application, as amended, are in condition for allowance. If the Examiner has any questions, he is invited to contact the undersigned at (503) 264-0967. Reconsideration of this patent application and early allowance of all the claims, as amended, is respectfully requested.

Respectfully submitted,

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